

REMARKS

Claims 23-34 and 47-54 are now pending in the application. Claims 27, 28, 30-34 and 47-54 are allowed. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

REJECTION UNDER 35 U.S.C. § 102

Claims 23, 24, and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Mufford (U.S. Pat. No. 6,186,254). This rejection is respectfully traversed.

With respect to claim 23, as previously asserted by Applicants, Mufford fails to disclose a controller that controls a hydrogen supply and an air supply to power a heater to warm a fuel cell stack and a water supply **while a vehicle is not running**. This much has been settled pursuant to the Pre-Appeal Conference held after Applicants' request filed March 31, 2009. (See Page 2 of the Non-Final Office Action mailed June 22, 2009).

The Examiner now relies upon a theory of inherency in rejecting claim 23. Specifically, the Examiner alleges that "starting the fuel cell is not synonymous to starting the motor, and thus the fuel cell is capable of heating the heater with or without the vehicle motor running." (See Page 3 and Page 6 of the present Office Action).

First, Applicant notes that Mufford describes the fuel cell 30 supplying power while the vehicle of Mufford is running – not while the vehicle is not running. For example, Mufford states that "[f]uel cell power may be advantageously used to power the resistor soon after start-up . . ." (See column 4, lines 39-40). Mufford also states

that fuel cell power may be used “**during operation . . . especially when the motor vehicle is operated** in cool ambient temperatures.” (See column 4, lines 42-46) (emphasis added). However, Mufford is **silent** as to the fuel cell 30 supplying power while the vehicle is not running.

Second, Applicant notes that the fact that a certain characteristic **may occur or be present** in the prior art reference is **not** sufficient to establish inherency of that characteristic. *In re Rijckaert*, 28 USPQ.2d 1955, 1957 (Fed. Cir. 1993) (emphasis added). Instead, as stated by the Federal Circuit:

[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities.’

In re Robertson, 49 USPQ.2d 1949, 1950-1951 (Fed. Cir. 1999) (emphasis added). In other words, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art.” *Ex Parte Levy*, 17 USPQ.2d 1461 (Bd. Pat. App. & Inter. 1990) (emphasis original).

Here, the Examiner failed to provide any basis or technical reasoning that Mufford necessarily controls a hydrogen supply and an air supply to power a heater to warm a fuel cell stack and a water supply **while a vehicle is not running**. Instead, the alleged inherency of the limitations of claim 23 appears to be solely the Examiner’s opinion as to the capabilities of the system of Mufford. Accordingly, Applicant respectfully asserts that the rejection based on inherency is improper.

For at least the above reasons, Applicant respectfully asserts that claim 23 is allowable. The remaining claims depend from claim 23 and, therefore, are allowable for at least similar reasons.

FINALITY OF REJECTION

Applicant respectfully submits that the finality of the present Office Action is premature. “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims....” MPEP § 706.07(a).

In the Non-Final Office Action mailed June 22, 2009, the Examiner stated that the limitation of when the vehicle is not running “was not given patentable weight.” (See Page 2 of the Non-Final Office Action mailed June 22, 2009). Thus, the Examiner failed to provide a complete examination of the claims. As best understood by Applicant, the Examiner now affords the limitation patentable weight and relies on the newly included theory of inherency discussed above. Accordingly, the Examiner has introduced a new ground of rejection (i.e., inherency).

Under MPEP § 706.07(a), unless the new ground of rejection was necessitated by Applicant’s amendment, the finality of this Office Action is premature. Here, Applicant did not amend the claims in Applicant’s Response filed August 21, 2009. Thus, the new ground of rejection was not necessitated by an amendment by Applicant. Therefore, the finality of the present Office Action is premature.

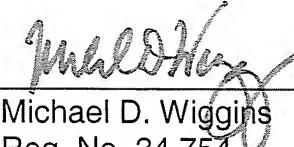
For at least these reasons, Applicant requests under MPEP § 706.07(d) that the Examiner reconsider and withdraw the finality of the present Office Action.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 1/7/10

By: 
Michael D. Wiggins
Reg. No. 34,754

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600

MDW/NSD/kam